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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/386,339	08/31/1999	HIROSHI KATSURABAYASHI	104122	1316
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OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER MEINECKE DIAZ, SUSANNA M	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 08/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/386,339

Applicant(s)

KATSURABAYASHI ET AL.

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 2-11, 13-24, 26 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 12, 25 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This non-final Office action is responsive to Applicant's election filed June 20, 2005.

Applicant has elected Species I with traverse, arguing that all species should be examined because "the search and examination of the entire application could be made without serious burden" (page 1 of Applicant's election). However, the Examiner respectfully disagrees. The specification sets forth three separate species directed toward an alternate embodiment for an optimum operator selection support system. Species I performs operator selection by analyzing a group of documents authored by one operator to extract certain key words and determine their respective frequency of usage in order to determine the operator's expertise. Species II performs operator selection by extracting the roles of operations for the execution of jobs and analyzing a group of documents related to a particular project, thereby incorporating an assessment of job order relations. Species III performs operator selection by analyzing conversations among multiple operators (e.g., via electronic mail) and extracting job features; a mail quotation deletion service may be used with this species. The specification discloses each species as mutually exclusive and unobvious variants over one another. Further, while these species share a generic searchable concept (i.e., optimum operator selection support systems), each species requires a unique specialized search. Therefore, the Examiner submits that it would be burdensome for the Examiner to search all species. Additionally, Applicant has not asserted that the species are not patentably distinct.

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Applicant submits that "at least claims 1-4, 8-25, and 28 read on elected Species I" (page 1 of Applicant's election). The Examiner respectfully disagrees. Many of the claims recite aspects of multiple species in the same claim, which is improper since Applicant's specification does not provide support for an active integration of all three species into one embodiment. This is further evidenced by Applicant's reference to the separate species as three different "aspects" (or embodiments) of the present invention (please see at least pages 10-12 and 39-41 of the specification). Species I is described in detail on page 17 (first full paragraph) through page 18 (line 5) of the specification. The Examiner submits that claims 2-11, 13-24, 26, and 27 comprise limitations that are directed toward the non-elected Species II and III and therefore stand as non-elected claims.

Claims 1, 12, 25, and 28 are directed toward Species I, which emphasizes assessment of a single operator based on a plurality of documents generated by that operator.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

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The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because it is too long. Correction is required. See MPEP § 608.01(b).

Claim Objections

4. Claim 28 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 12, and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 12, and 28 recite "a computer executing an optimum operator selection support system" (i.e., apparatus claims) comprising various parts *per se*. These parts seem to refer to software modules. If this is the case, then the parts are interpreted as software *per se* since they are not directly integrated with any structural elements (e.g., they are not expressly recited as executed by the computer). Apparatus claims are

defined by their structural limitations. Without any structural elements recited, claims 1, 12, and 28 are deemed to be improper apparatus claims.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1, 12, and 28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1, 12, and 28 recite "a computer executing an optimum operator selection support system" (i.e., apparatus claims) comprising various parts *per se*. These parts seem to refer to software modules. If this is the case, then the parts are interpreted as software *per se* since they are not directly integrated with any structural elements (e.g., they are not expressly recited as executed by the computer). Software *per se* is non-statutory under 35 U.S.C. 101; therefore, claims 1, 12, and 28 are deemed to be non-statutory.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1, 12, 25, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Gilmour et al. (U.S. Patent No. 6,115,709).

Gilmour discloses a computer executing an optimum operator selection support system, comprising:

[Claim 1] a document management part that manages documents stored by said computer related to jobs, with additional information on operators who generated the documents (Figs. 4-6; col. 4, line 48 through col. 5, line 11; col. 5, lines 23-30; col. 14, lines 50-58);

a document feature extraction part that extracts a plurality of documents generated by a same operator from said document management part, and extracts features of the respective documents (col. 4, line 48 through col. 5, line 11; col. 5, lines 23-30; col. 14, lines 50-58); and

a job feature extraction part that extracts features of jobs of said operator by detecting common features based on a frequency of occurrence of terms in the plurality of documents extracted by said document feature extraction part (col. 4, line 48 through col. 5, line 11; col. 5, lines 23-30; col. 14, lines 50-58 -- Knowledge bases held by an individual within an organization/corporation are identified. This knowledge can be related to special work/job environments, such as manufacturing or accounting);

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[Claim 12] an optimum operator selection part that selects optimum operators based on information extracted by said job feature extraction part (Fig. 18D; col. 5, lines 23-30; col. 22, lines 23-38 -- Optimum sources of a particular type of knowledge are identified. They may be identified and ranked as potential recipients for a given e-mail);

[Claim 28] wherein the plurality of documents is authored by the same operator (col. 4, line 64; col. 5, lines 1-3).

[Claim 25] Claim 25 recites limitations already addressed by the rejection of claim 1; therefore, the same rejection applies.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,581,105 – Discloses a system that parses e-mail messages for support person skill set information in order to determine to whom a call should be routed.

US 2004/0139042 – Discloses a knowledge management system that derives knowledge about people's expertise from the content of their e-mail documents.

US 2004/0133571 – Discloses a system that analyzes the documents authored by a user in order to derive information about the user's expertise.

Shimazu ("Knowledge Discovery in Database by PROGOL – Design, Implementation and its Application to Expert System Building") -- Discusses the

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assignee's (Fuji Xerox Co. Ltd.) relation to a project involving automatic knowledge acquisition of expertise in an e-mail classification expert system.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Susanna M. Diaz
Primary Examiner
Art Unit 3623

August 26, 2005